

REMARKS – Summary

The Examiner's rejections are respectfully flawed for the following principal reasons:

1. First and contrary to the assertion made in the rejection, there are a number of limitations found in the independent claims 14, 36, and 45, specifically Claim 14 Clauses (c)(ii), (c)(iv), (c)(v), (c)(vi); Claim 36 Clauses (c)(ii), (c)(iv), (c)(v), (c)(vi), and Claim 45 Clauses (b), (c), (d) and (e), that are not taught or suggested in Petrovich. Moreover, these limitations are also missing from Suzuki and Ruppert, even when considered in view of Petrovich. Therefore, a *prima facie* case of obviousness *cannot* be established by these three references with respect to the above-identified limitations.

2. Second, the limitation regarding the prediction of the product to be replaced, i.e., Claim 14 Clauses (c)(iv), (c)(v), (c)(vi); Claim 36 Clauses (c)(iv), (c)(v), (c)(vi), and Claim 45 Clauses (c), (d) and (e), is, in fact, not taught or suggested by Suzuki. Suzuki uses a single date, i.e. the last purchase date of a “necessity” item, which is impractical in consideration of Applicant’s invention’s reliance on a multiplicity of previously entered barcode timestamps for any item in which the consumer is interested. Therefore, even if Suzuki is combined with Petrovich, the invention as defined by the independent claims in Applicant's invention would *not* be present as suggested by Examiner through a modification of Petrovich and a *prima facie* case of obviousness is *not* established.

3. Third, Suzuki depends upon the “last purchase date” of a “necessity” item. Applicant’s claimed invention does not depend upon the “last purchase date” of a “necessity” item, but uses a multiplicity of previously entered / scanned barcodes of an item that the consumer is interested in. Therefore, even if Suzuki is combined with Petrovich, the invention as defined by the independent claims in Applicant's invention would *not* be present as

suggested by Examiner through a modification of Petrovich and a *prima facie* case of obviousness is *not* established.

4. Fourth, both Petrovich and Suzuki depend upon a store / shopping establishment to implement their respective invention. Applicant's claimed invention is independent of whether or not a shopping establishment / store implements the invention. Therefore, even if Suzuki is combined with Petrovich, the invention as defined by the independent claims in Applicant's invention would *not* be present as suggested by Examiner through a modification of Petrovich and a *prima facie* case of obviousness is *not* established.
5. Fifth, Applicant's "consumer's first computer" cannot be construed as Petrovich's "host computer", which is obvious to one skilled in the art, belongs to and is located in a Petrovich shopping establishment. This is an important distinction in the use of computer systems between Petrovich and Applicant's invention. Petrovich relies on the "shopping establishment" to provide information processing, whereas Applicant's "consumer's first computer" provides the processing and intelligence needed in setting up and maintaining a consumer's predictive shopping list database, which Petrovich does *not* teach.
6. Sixth, Applicant's "consumer's first computer" cannot be construed as Petrovich's "portable terminal", which is obvious to one skilled in the art that it is similar to Applicant's claimed "portable barcode scanner".
7. Official Notice has been taken with respect to Applicant's new and unexpected use of a scanned / entered barcode's date and timestamp. Examiner's claim of Official Notice was and continues to be unsupported by documentary evidence. In Applicant's previous responses to Office Actions (i.e. Applicant's Amendment E dated April 02 2008, Amendment F dated

May 12 2008 and Amendment G dated Feb. 18 2009) Applicant respectfully challenged Examiner's Official Notice and requested evidence to support this stated Official Notice [37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697]. Examiner did *not* provide this evidence in *any* of the subsequent Office Actions, as well as the current Office Action (dated May 01, 2009) in response to Applicant's challenge.

8. Examiner has liberally used hindsight, which is improper to determine obviousness under 35 U.S.C.A. 103(a) [Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983) and Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988)]. All of the above mentioned limitations are in fact *not* taught *or* suggested by Petrovich, Suzuki and Ruppert. Therefore, even if Suzuki and Ruppert are combined with Petrovich, the invention as defined by Applicant's independent claims would *not* be present through a legal modification of Petrovich and a *prima facie* case of obviousness is therefore *not* established.
9. Furthermore, Examiner has made various conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)]. Therefore, even if Suzuki and Ruppert are combined with Petrovich, the invention as defined by Applicant's independent claims would *not* be present through a legal modification of Petrovich and a *prima facie* case of obviousness is therefore *not* established.
10. Any continued claim that Petrovich, Suzuki and Ruppert can be modified so that the missing claim limitations are present is a clear use of hindsight, which the U.S.P.T.O. Board of Appeals has ruled against, in consistent agreement with the courts.

Applicant respectfully submits that combining Petrovich, Suzuki and Ruppert is *not* legally justified and is therefore improper [In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983), Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988) and Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993)]. Applicant respectfully submits that the rejections on these references be withdrawn.

REMARKS

Re Examiner's Response To Applicant's Claims

- 4.1) Re Examiner's response [4], Applicant respectfully requests that Examiner reconsider Rejections under 35 USC § 103 of Claims 14-20, 34-39, 41-46 and 63-64 as being un-patentable over Petrovich et al (US PG Pub. No. 2003/0061113 A1) in view of the Suzuki (US Patent No. 6,129,274), as well as in further view of Ruppert et al (US Patent No. 5,424,524).

Petrovich et al, Suzuki and Ruppert et al do *not* teach the *new and unexpected use of a multiplicity of date and timestamps of previously scanned / entered shopping list product barcodes to set up a predictive shopping list database of a consumer's commonly and frequently used / needed products, using the consumer's own computer.*

Applicant's claimed consumer's shopping list database, which is *located on the consumer's own computer and not on Petrovich's "host computer", nor on Petrovich's "portable terminal"*, is used not only to generate a list of barcoded products that the consumer has currently entered / scanned into the system (e.g. on May 24, 2009 at 10:00), but is used as well in order *to predict if and when the consumer will need to shop (in-store or online) for a product*

which the consumer may not be aware of at the current moment, i.e. when the consumer generates a new / current shopping list (e.g. on May 24, 2009 at 10:00).

Applicant's claimed invention [specifically Claims 14(iv), 14(v), 14(vi), 36(iv), 36(v), 36(vi) and 45(b), 45(c), 45(d) and 45(e)] will ascertain whether or not previously entered barcoded products (e.g. on May 1, 2009 at 08:00, on May 14, 2009 at 17:00 and on May 17, 2009 at 20:00), should also be placed on the consumer's current shopping list (e.g. on May 24, 2009 at 10:00) *even though the consumer has not entered the products' barcodes on his current / new shopping list.*

In other words, Applicant's invention learns over a period of time, i.e. over multiple dates and times (and not via a single date as Suzuki teaches by using the "**last purchase date [...] of a necessity item**"), the consumption habits of the consumer by building a database of previously scanned / entered shopping lists, by means of including the date and time, every time the consumer enters each product into the invention and **not** simply the last time that the shopper purchased the product in a store, as taught by Suzuki.

It is commonly known in mathematical statistics that using a single datum as Suzuki teaches to predict whether or not a shopper needs a previously purchased item is statistically ineffective, whereas Applicant's use of multiple data statistically provides a much, much more effective predictive application of whether or not a shopper needs an item that she previously purchased as taught in Suzuki, or scanned / entered as claimed by Applicant.

This new and unexpected use of the dates and times on which a product's barcode was previously entered / scanned (i.e. not necessarily purchased as taught by Suzuki) into a shopping list in Applicant's invention is important to the Applicant's invention's *non-obvious* use of a predictive

shopping list database to aid a consumer. *Consequently Applicant's invention can automatically add items to the consumer's current / new shopping list, even though the consumer may be unaware that he needs the items, which the invention automatically adds to his current / new shopping list.*

4.2) Regarding Examiner's rejections of Claim 14(c);

(i) Applicant's claim does not claim any "sub-steps" as listed by Examiner. Applicant assumes that this is a "typo" by Examiner.
(ii) Examiner's cited reference of Petrovich "**see at least Para. 0103**" does *not* teach Applicant's claimed "using one or more consumer's first computers". Petrovich Para. 0103 teaches using a "**portable terminal 40**", which is in practice akin to Applicant's portable barcode scanner and *not* Applicant's claimed "consumer's first computers".

(iii) Examiner's citation of Petrovich "**see at least Para. 0103**" does *not* teach Applicant's claimed step of "receiving data from, and transmitting data to, said portable barcode scanner over a consumer's first network infrastructure" (emphasis added). Petrovich "**Para. 0103**" teaches communications between Petrovich's "portable terminal 40", i.e. a barcode scanner and "an establishment from which the order is to be placed" via Petrovich's "portable terminal receiving station 32 of home cradle 30", which then "dials up" the appropriate **shopping establishment 14'** (emphasis added. See Petrovich Para. 0104) such that the "[p]ortable terminal 40 can download the entire shopping list **to the host computer 16**" (emphasis added. See Petrovich Para. 0104). Petrovich's "host computer 16" in ***no manner*** can be construed by one knowledgeable in the art as Applicant's "consumer's first computer", but is obviously a computer which belongs to, and is located at Petrovich's shopping establishment (see at least **Fig 1**,

symbol 16; Abstract; Para 0015-0020; Para 0061-0063; Para 0068-0070; Para 0086-0090; Para 0097-0099; Para 0104-0105; Para 0108; Para 0118; Para 0122; Para 0124; Para 0128-0129; Para 0137-0138; Para 0141).

(iv) Examiner's citation of Petrovich "see at least Para. 0103-0109, 0118" does *not* teach Applicant's claimed step of "storing said data in a memory means on said first computer as a current shopping list" (emphasis added). Petrovich Para. 0103-0109 teaches "[s]eparate files for each of a number of shopping establishments can be created in the memory 46 of the portable 40. Memory 46 can thus be configured to store multiple lists of data associated with the bar codes, as multiple shopping lists corresponding to multiple shopping establishments" (emphasis added). Again, *in no manner* can Petrovich's "memory 46" be construed by one knowledgeable in the art as Applicant's claimed "memory means on said first computer". To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

Examiner's reference of Petrovich 0118 teaches a shopping establishment's "stackable cradle assemble", which is *not* connected to "a consumer's first network infrastructure" as claimed by Applicant.

Petrovich's "stackable cradle assemble" is connected to the shopping establishment's host computer, which as mentioned previously *cannot*, to one knowledgeable in the art, be construed as Applicant's claimed "consumer's first computers" (see at least Petrovich Fig 1, **symbol 16; Abstract; Para 0015-0020; Para 0061-0063; Para 0068-0070; Para 0086-0090; Para 0097-0099; Para 0104-0105; Para 0108; Para 0118; Para 0122; Para 0124; Para 0128-0129; Para 0137-0138; Para 0141).** To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl

Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

(v) Examiner's reference of Petrovich "see at least 0118, 0103-0109" does *not* teach Applicant's claimed step "communicating with a second computer system using said first computer, over a second network infrastructure". Petrovich Para. 0103-0109 teaches communication between Petrovich's "portable terminal 40" and a shopping establishment's "host computer 16".

Petrovich Para. 0118 teaches in-store docking Petrovich's "portable terminal 40" in a shopping establishment's "stackable cradle assemble", which is connected to the shopping establishment's "host computer 16". Clearly Petrovich's "host computer 16" *cannot* be construed by one knowledgeable in the art as Applicant's claimed "consumer's first computers" (see at least Petrovich Fig 1, symbol 16; Abstract; Para 0015-0020; Para 0061-0063; Para 0068-0070; Para 0086-0090; Para 0097-0099; Para 0104-0105; Para 0108; Para 0118; Para 0122; Para 0124; Para 0128-0129; Para 0137-0138; Para 0141). To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

(vi) Examiner's reference of Petrovich "see at least 0088, claim 78" does *not* teach Applicant's claimed step "displaying a multiplicity of said product barcodes or said product coupon barcodes, together with additional shopping list information, on said consumer's first computer display" (emphasis added). Petrovich Para. 0088 teaches (a) communication between Petrovich's "portable terminal 40", i.e. bar code scanner, and the shopping establishment's "host computer 16", and (b) "displaying relevant portions of the shopping list database, [...] on the display 72 of the

portable terminal 40" (emphasis added). Similarly Petrovich **Claim 78** teaches "displaying said list at said portable terminal" (emphasis added). Once again, it is inconceivable to one knowledgeable in the art to construe Petrovich's "display 72 of the portable terminal 40" as Applicant's claimed "consumer's first computer display".

(vii) Examiner's reference of Petrovich "**see at least 0103-0109**" does *not* teach Applicant's claimed step "indicating on said first computer display that said consumer has obtained said current shopping list in-hand from said consumer's first computer" (emphasis added).

(viii) Examiner's reference of Petrovich "**see at least 0103-0109**" does *not* teach Applicant's claimed step "indicating that said data transmitted to and said data received from said portable barcode scanner has been successfully sent and received".

4.3) Examiner's rejection of Claim 14(d) by citing Petrovich "**(see at least Para 0118, 0103-109)**" does *not* address Applicant's claim of "transferring said scanned product barcode or said product coupon barcode to said consumer's first computer, over said first network infrastructure" (emphasis added).

Petrovich's "host computer" is clearly *not* Applicant's claimed "consumer's first computer", but is a computer which obviously belongs to, and is located in a "shopping establishment" (see at least Fig 1, symbol 16; Abstract; Para 0015-0020; Para 0061-0063; Para 0068-0070; Para 0086-0090; Para 0097-0099; Para 0104-0105; Para 0108; Para 0118; Para 0122; Para 0124; Para 0128-0129; Para 0137-0138; Para 0141).

Applicant's claimed "consumer's first computer" does not belong to, nor is it located in Petrovich's "shopping establishment", but belongs to Applicant's claimed consumer and is located within the consumer's

premises (whereas Petrovich's "host computer" does belong to and is located in a shopping establishment). This is an important distinction in the use of computer systems between Petrovich and Applicant's invention. Petrovich's invention relies on the "shopping establishment host computer" to provide information processing, whereas Applicant's "consumer's first computer" provides the processing and intelligence needed in setting up and maintaining a consumer's predictive shopping list database. Furthermore and fundamentally importantly, Petrovich's "host computer 1.6" does *not* teach setting up a predictive shopping list database as claimed by Applicant's invention.

Applicant's invention is also independent of any "shopping establishment" adoption of Applicant's invention. It is obvious to one knowledgeable in the art that Petrovich (and Suzuki) is dependent on a "shopping establishment" implementing the invention.

4.4) Examiner's rejection of Claim 14(e) by citing Petrovich "(see at least Para 0012, 0020, 0068)" clearly does *not* teach Applicant's claim of "storing said transferred product barcode or said product coupon barcode in a shopping list database on said consumer's first computer" (emphasis added):

(i) Petrovich **Para 0012** teaches: "It is yet a further object of the present invention to provide an improved portable terminal which can be used by a given consumer in both a home and store location, and can perform enhanced shopping database management" (emphasis added). Clearly there is *no* mention, *nor* suggestion of Applicant's claim 14(e), i.e. "storing said transferred product barcode [...] in a shopping list database on said consumer's first computer" (emphasis added). Petrovich's "improved portable terminal" is clearly *not* Applicant's claimed "consumer's first computer". To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are

unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

(ii) Petrovich **Para 0020** discusses “storing data associated with the bar codes in a memory of the portable terminal” (emphasis added) and *not* “storing said transferred product barcode [...] in a shopping list database on said consumer's first computer” (emphasis added) as claimed by Applicant. Once again, one knowledgeable in art *cannot* construe Petrovich’s “portable terminal” under any reasonable circumstance as Applicant’s claimed “consumer’s first computer”. To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

(iii) Petrovich **Para 0068** discusses a “home data transfer circuit 36 [which] supplies **host computer 16** with the data associated with the bar codes of the shopping-related items 44 when the **portable terminal 40** is received in the home portable terminal-receiving station 32 [...] **Host computer 16** receives the data associated with the bar codes of the shopping-related items 44 and stores the data in a shopping list database” (emphasis added). Petrovich's “host computer” obviously belongs to, and is located in the “shopping establishment” and is *not* a “consumer’s first computer” as claimed by Applicant. It is obvious that Petrovich does *not* teach “storing said transferred product barcode or said product coupon barcode in a shopping list database on said consumer's first computer” (emphasis added) as claimed by Applicant. Clearly Petrovich teaches storing bar codes on a “**portable terminal**”, i.e. a barcode scanner, and then transferring this list from the scanner to a “**shopping establishment's host**

computer", and thereby does *not* teach Applicant's invention. Once again, one knowledgeable in the art *cannot* construe Petrovich's "portable terminal" under any reasonable circumstance as Applicant's claimed "consumer's first computer". It is obvious that Applicant's claimed "consumer's first computer" does *not* belong to, *nor* is it located in Petrovich's "shopping establishment", but belongs to Applicant's claimed consumer and is located within the consumer's premises. To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

4.5) Examiner's rejection of Claim 14(f) by citing Petrovich "**(see at least Para 0005 [...] 0012,0016,0017,00103-109)**" clearly does *not* teach Applicant's claim:

(i) Petrovich **Para 0005** teaches US Patent No. 5,047,614 to Bianco, wherein a person "can dock the bar code reader in a kiosk at a store, and can then receive a printed shopping list with directions" (emphasis added). Clearly Bianco as taught in Petrovich **Para 0005** does *not* teach "obtaining in-hand said stored current shopping list information from said consumer's first computer in order to go to a first store" (emphasis added) as claimed by Applicant, but teaches the need *to go first* to "a store" in order to "receive printed shopping list".

(ii) Petrovich **Para 0012,0016,0017,0103-0109** clearly do *not* teach the capability of "obtaining in-hand said stored current shopping list information from said consumer's first computer in order to go to a first store" (emphasis added) as claimed by Applicant.

(iii) Petrovich Para 0012 does not teach using Applicant's invention's consumer's "first computer", but teaches "an improved portable terminal", which is analogous to one knowledgeable in the art, to Applicant's portable barcode scanner. Applicant's invention teaches a new and unexpected use of a consumer's "first computer" in conjunction with a portable barcode scanner, i.e. Petrovich's "portable terminal".

(iv) Petrovich Para 0016 teaches a "shopping establishment kiosk cradle" and not a "consumer's first computer", i.e. in-store use of Petrovich.

(v) Petrovich Para 0017 teaches a "home cradle" and a "home data transfer circuit [that] supplies the host computer with the data associated with the bar codes when the portable terminal". As discussed above (see [4.3]), clearly Petrovich's "host computer" belongs to, and is located in the "shopping establishment", i.e. a store, and is not a "consumer's first computer" as claimed by Applicant. Applicant's claimed "consumer's first computer" does not belong to, nor is it located in Petrovich's "shopping establishment", but belongs to Applicant's claimed consumer and is located within the consumer's premises. To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

(vi) Petrovich Para 0103-0109 teaches in-store use of Petrovich's "portable terminal", i.e. barcode scanner and not "obtaining in-hand said stored current shopping list information from said consumer's first computer in order to go to a first store" (emphasis added) as claimed by Applicant. Petrovich Para 0103-0109 teaches a customer already being in a store where Petrovich's "portable terminal" is used. To suggest

otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983)].

Clearly Examiner's cited references do *not* teach Applicant's claimed invention.

4.6) Examiner's rejection of Claim 14 by citing Suzuki (see at least col. 14 lines 1-35) "teaches wherein the processor based on customer's shopping history information (i.e. previous shopping list) is able to make purchase recommendations for replenishment items by analyzing the last purchase date of a necessity item from the shopping history" (emphasis added). Examiner then states that "i.e. tracking frequency and providing notification of previous shopping list information stored in memory". Firstly, in no reasonable way can it be construed by one knowledgeable in the art that Suzuki's "last purchase date of a necessity item" is a "tracking frequency" as defined and claimed by Applicant. A single purchase in Suzuki is clearly not Applicant's claimed "tracking frequency", "wherein said collecting and storing of said multiplicity of dates and times providing a means to learn said consumer's rate of consumption of each said product; wherein said means of learning said consumer's rate of consumption of each said product is a consumption tracking frequency of each said product; said consumption tracking frequency of each said product providing a means to predict when each said product needs to be replaced" (emphasis added). To suggest otherwise, is to use conjectural modifications of prior art disclosures, which are unwarranted by such disclosures and therefore are improper [Carl Schenck, A.G. v. Norton Corp., 713 F.2d 782, 218 U.S.P.Q. (BNA) 698, 702

(Fed. Cir. 1983)].

Examiner then claims that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Suzuki to the disclosure of Petrovich in order to refill or replenish frequently needed items". Applicant respectfully **disagrees** with Examiner's conclusions for the following fundamental and obvious reasons:

(i) Firstly, Suzuki relies simply on the "last purchase date of a necessity item from the shopping history" (emphasis added) as specified by Examiner's cited reference (see col. 14 lines 1-35), whereas Applicant's invention claims using a multiplicity of an item's previously scanned / entered dates and times in order to determine the consumer's rate of consumption of any product, whether or not the item may be regarded as a "necessity", (i.e. setting up and maintaining a *predictive* shopping list database on a consumer's computer for *all* items that are of interest to a consumer, which Suzuki obviously does *not* teach). For example, consider a consumer who only purchases dish-wash liquid once every three (3) months (e.g. a very large container), but shops daily for groceries, etc. In this scenario, Suzuki may *not* determine, for example after sixty or more separate visits of shopping by the consumer, that dish-wash liquid is needed again, because (i) it may not be a Suzuki "necessity" and (ii) the memory in Suzuki's "IC card [...] recirculating information storage area" (see at least Col. 11, lines 4 - 15) may have been overwritten with other "necessity" items by the time the customer shops again for his dish-wash liquid. Applicant's invention would easily determine such a need based upon the predictive database's tracking frequency collection of previous entries of dish-wash liquid on a "multiplicity" of dates. Clearly Suzuki does *not* teach Applicant's claimed invention.

(iii) Suzuki teaches using the “last purchase date of a necessity item from the shopping history” at a store’s checkout (emphasis added. See at least col. 14 lines 1-35), which is stored in an “IC card” carried by the consumer (see at least Fig. 1, Fig. 2; col. 1 lines 7-12; col. 4 lines 13-19; col. 6 lines 15-67; col. 9 lines 1-67; col. 11 lines 3-19, 60-67; col. 12 lines 35-42 and col. 14 lines 1-35). Suzuki’s solution is therefore obviously limited to stores that have implemented Suzuki’s invention. So for example, consider if a consumer decides to shop at another store, which could be a competitor’s store, and where Suzuki’s invention has *not* been implemented. In this case the consumer would *not* be the recipient of the store being “able to make purchase recommendations for replenishment items by analyzing the last purchase date of a necessity item from the shopping history”.

This further *limitation* of Suzuki does *not* teach Applicant’s invention which does not rely any specific store implementing Applicant’s invention, i.e. unlike Suzuki which requires a consumer to use Suzuki’s invention’s “IC card” and to shop at a store which has implemented Suzuki’s invention, specifically the associated “IC card” reader software, as well as software on the store’s computer, that is “able to make purchase recommendations for replenishment items by analyzing the last purchase date of a necessity item from the shopping history”.

(iv) Suzuki teaches that for a consumer to be reminded of a “necessity item from the shopping history” (emphasis added), the consumer must be *in a store using a specific portable* “IC card” (see at least Fig. 1, Fig. 2; col. 1 lines 7-12; col. 4 lines 13-19; col. 6 lines 15-67; col. 9 lines 1-67; col. 11 lines 3-19, 60-67; col. 12 lines 35-42 and col. 14 lines 1-35). This further *limitation* of Suzuki *teaches away* from the Applicant’s invention that does *not* rely on a specific store’s capability to read, **in-store**, a consumer’s “shopping history” off of a consumer’s

Suzuki "IC card" in order to be reminded of any necessity items which the consumer may have, or soon will be running out of, based upon Suzuki's "last purchase date" of the necessity items. In Applicant's invention, by the time a consumer has entered *any* store, the consumer already has a shopping list **in-hand**, which may include **non** Suzuki-necessity-items, and is *independent* of whether or not the store has implemented Applicant's invention.

(v) Furthermore, Applicant's previously scanned / entered shopping list items do **not** require an item to have been previously "purchased", as is taught by Suzuki (i.e. "last purchase date"), but simply to have been scanned or manually entered into Applicant's invention.

In conclusion it would **not** have been obvious to one of ordinary skill in the art at the time of Applicant's invention, that to incorporate Suzuki to the disclosure of Petrovich would "remind the customer to refill or replenish frequently needed items" in the **new and unexpected way in which Applicant's invention claims**. In other words, combining Suzuki in view of Petrovich clearly does **not** teach Applicant's claimed invention, but instead teaches away from Applicant's invention.

4.7) Examiner on Page 5 and 6 states that it "would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the disclosure of Petrovich in view of Suzuki to include the time and date of when the barcode was scanned in order to create an efficient shopping list for the customer". As clearly shown above in [4.6] by Applicant, Petrovich in view of Suzuki does **not** teach Applicant's invention, but instead teaches away from Applicant's invention.

4.8) Furthermore, on Page 6 Examiner states that “recording the date and time [of] when [a] barcode was scanned is well known and old in the art at the time the invention was made as stated in the previous office action, and is admitted prior art since applicant failed to properly traverse the Official notice in the previous action”. Applicant respectfully *objects* to Examiner’s conclusion for the following reasons:

- (a) The Applicant did traverse this objection by Examiner in the previous action (i.e. see Applicant’s Amendment G dated Feb. 18 2009, Amendment F dated May 12 2008 and Amendment E dated April 02, 2008) and clearly showed that Applicant’s use of the date and timestamps of a scanned barcode is non-obvious in consideration of prior art, because it teaches a new and unexpected use of the recording of the dates and times when a barcode was scanned / entered, i.e. setting up and actively using a predictive shopping list database on a consumers computer. Furthermore, in this current Office Action (dated May 01, 2009), Examiner *did not point out why the Applicant’s traversal was unacceptable*, as required by 37 CFR 1.104(c)(2) and as stated in Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697. Examiner simply stated in the current Office Action (dated May 01, 2009), on Page 9 in the **“Response to Arguments”**: “Applicant’s arguments have been considered but are moot in view of new ground(s) of rejection”, but Examiner went on to re-claim similar objections as in the previous Office Action (dated Oct. 30, 2008).
- (b) Examiner’s claim of Official Notice was and continues to be *unsupported by documentary evidence*. In Applicant’s previous responses to Office Actions (i.e. Applicant’s Amendment E dated April 02 2008, Amendment F dated May 12 2008 and Amendment G dated Feb. 18 2009) Applicant respectfully challenged Examiner’s Official Notice and requested evidence to support this stated Official Notice [37 C.F.R.

1.104(c)(2), 37 C.F.R. 1.104(d)(2) and Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697]. Examiner did *not* provide this evidence in the current Office Action (dated Oct. 30, 2008) in response to Applicant's challenge.

Once again, Applicant respectfully *challenges* Examiner's "Official Notice that the time and date of when the barcode was scanned is well known and old in the art at the time of invention" and again respectfully requests evidence to support this claim in accordance with 37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697.

4 . 9) Applicant's first previous traversal of this objection (i.e. Applicant's Amendment E dated April 02, 2008) is included below, *which remains pertinent to the current Official Notice* (dated May 01, 2009) objection by the Examiner:

"7.3) The Examiner's taking Official Notice that "including the time and date when the barcode was scanned is well know and old in the art at the time the invention was made" is noted, but Applicant respectfully brings the Examiner's attention to the fact that how, i.e. the manner in which the date and time stamp is used by Applicant's invention is new and unexpected and therefore non-obvious in the art. Applicant has modified Claims 14 and 36 to further clarify this non-obvious new and unexpected use of an entered barcode's date and time stamp.

Applicant teaches the non-obvious new and unexpected use of the entered barcode's date and time stamp to create on the "consumer's first computer" a predictive shopping list database of

the consumer's past consumption habits. This predictive shopping list database system is activated when the consumer creates a new shopping list (i.e. a current shopping list) in order to go shopping. This activation includes automatically placing, i.e. adding items to the current shopping list, without the consumer's "current" intervention, because it "knows" products that the consumer has most probably run out of, or is soon to run out of and consequently most probably needs, but has neglected (i.e. has forgotten or is unaware of the current need) to enter the item(s) on the current shopping list.

In the advent that this clarification of
Applicant's invention's non-obvious, new and
unexpected use of the entered barcode's date and
time stamp is respectfully unsatisfactory in the
Examiner's continued taking Official Notice,
Applicant respectfully challenges the Examiner's
"Official Notice that the time and date of when
the barcode was scanned is well known and old in
the art at the time of invention" and
respectfully requests evidence to support this
claim (see 37 C.F.R. 1.104(c)(2), 37 C.F.R.
1.104(d)(2) and Zurko, 258 F.3d at 1386, 59
USPQ2d at 1697)

8) The Examiner's response [A] that Applicant "failed to specially point out the supposed errors in the examiner's action" with respect to the Examiner's taking Official Notice of the date

and time stamp use has been addressed in part in Applicant's Remarks [7.3] above. Applicant shall endeavor to further traverse the Examiner's position in light of the requirements of 2144.03(c) as follows:

8.1) As stated in [7.3] above, Applicant's invention's teaching of the new and unexpected use of the entered barcodes' date and time stamps in order to build a predictive shopping list database of the consumer's past consumption habits, over a period of time, is non-obvious in the art.

In order further to traverse this argument, Applicant considers both of the sets of "References Cited" in, and "Referenced By" Ruppert et al. that use the terms (a) "bar code" or "barcode" and (b) "timestamp" or "time stamp" in each of the appropriate references' Specifications in order to determine whether or not Applicant's specific use of the date and time stamp of an entered barcode is "**well known and old in the art at the time of invention**".

8.1.1.) The only "References Cited" in Ruppert et al which include the above mentioned relevant terms (a) and (b) under consideration is Gutman et al patent number 5,221,838 (Gutman '838). Gutman '838 teaches "*a time stamp may be stored into memory 206 along with*

the received and recovered message information" [col. 7, lines 10-11], and hence "*time information may be included with the message that is transmitted to the selective call receiver 200*" [col. 11, lines 32-34].

At no point is it taught, nor suggested in Gutman '838, nor in any of the other five (5) "References Cited" in Ruppert et al, Applicant's non-obvious *new and unexpected use of the entered barcode's date and time stamp to create an active predictive shopping list database system on the consumer's computer*, which assists the consumer to shop for items that he has neglected to add to his current shopping list.

Gutman '838 teaches away from Applicant's *new and unexpected use of an entered barcode's date and time stamp*. Furthermore, the majority of the "References Cited" in Ruppert do not even mention capturing an entered barcode's date and time stamp, and hence do not teach either the non-obvious *new and unexpected use of the date and time stamp in order to create a predictive shopping list database as is taught by Applicant's invention*, nor "*that the time and date of when the*

barcode was scanned is well known and old in the art at the time of invention" as claimed by the Examiner's Official Notice under consideration.

8.2) As of March 24, 2008 two hundred and sixteen (216) patents were "Referenced By" Ruppert et al. Applicant narrowed this list down to those applications that include the above-mentioned relevant terms (a) and (b) under consideration. Applicant used the PatFT Query "REF/5424524 AND SPEC/(timestamp OR "timestamp") AND SPEC/(barcode OR "bar code")". This search returned only one (1) patent, i.e. Nulph patent number 7,247,095 (Nulph '095). Firstly, Nulph '095 was filed on October 8, 2004, i.e. after Applicant's filing date of February 13, 2001 and hence cannot be considered as prior art over Applicant's invention under 35 USC §102. Secondly, Nulph '095 teaches a "*Method and system for marketing and game selection for lottery products*" in which the date and time stamp of a gambling transaction is recorded. The "timestamp" term is mentioned twice (2) in Nulph '095, i.e. (1) "*information printed in relation to the specific lottery transaction of the player may include a date/timestamp 36 of the transaction*" [col. 10, lines 62-64] and (2) the "*date/timestamp 36 indicates that the play card 30 was printed on "Jul. 6, 2005 at 5:35 PM"*" [col. 11, lines 6-7]. Nulph '095 clearly teaches away from creating a predictive database of shopping lists as is taught by Applicant's

invention. Furthermore, the majority of the "Referenced By" Ruppert do not even mention capturing an entered barcode's date and time stamp, and hence do not teach either the non-obvious *new and unexpected use* of the date and time stamp in order to create a predictive shopping list database as is taught by Applicant's invention, nor "that the time and date of when the barcode was scanned is well known and old in the art at the time of invention" as respectfully claimed by the Examiner's Official Notice under consideration.

8.2) In conclusion Applicant respectfully submits that the Examiner's taking Official Notice that "including the time and date when the barcode was scanned is well known and old in the art at the time the invention was made" is not "well known and old in the art", which Applicant has dutifully traversed in the above mentioned and pertinent applications. Specifically, Applicant respectfully submits that in context of Applicant's new and unexpected use of an entered barcode's date and time stamp to create a predictive shopping list database system, that new and unexpected use of an entered barcode's date and time stamp is neither "well known" nor "old in the art".

Using the guidance gratefully provided by the Examiner in the Office Action dated 02/11/2008 to institute a proper traversal pointing out the

errors in the Examiner's Action, Applicant respectfully requests the Examiner, according to MPEP 2144.03(c), to "provide documentary evidence in the next Office action if the rejection is to be maintained". Alternatively Applicant respectfully requests that the invention as claimed should be considered non-obvious, making Applicant's Claims patentable under 35 USC § 103".

4.10) On Page 6 it is stated that Examiner "takes Official Notice that associating a time stamp to a scanned barcode or to a data [sic] to be stored is old and well known in the art at the time the invention was made". Applicant respectfully **objects** to Examiner's Official Notice conclusion in this case and objects to the admittance of this information as prior art. Applicant's objections are as follows:

- (i) The Applicant did traverse this objection by Examiner in the previous action (i.e. see Applicant's Amendment G dated Feb. 18, 2009) and clearly showed that Applicant's new and unexpected use of the date and timestamp of a scanned barcode is non-obvious in consideration of prior art. Furthermore, in this current Office Action (dated May 01 2009), Examiner did *not point out why Applicant's traversal was unacceptable* (i.e. Applicant's Amendment G dated Feb. 18, 2009), as required by 37 CFR 1.104(c)(2) and as stated in Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697. Examiner simply stated in the current Office Action (dated Oct. 30, 2008), on Page 9 in the "**Response to Arguments**": "Applicant's arguments have been considered but are moot in view of new ground(s) of rejection", but many of Examiner's old "ground(s) of rejection" were repeated almost verbatim.
- (ii) Furthermore, Examiner's claim of Official Notice was and continues to be unsupported by documentary evidence. In Applicant's previous office action

response (i.e. Applicant's Amendment G dated Feb. 18, 2009) Applicant respectfully *challenged* Examiner's Official Notice and *requested evidence* to support this taking of Official Notice [37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697]. Examiner did *not* provide this evidence in the current Office Action (dated May 01, 2009) in response to Applicant's challenge as required by law.

Once again, Applicant respectfully *challenges* Examiner's "Official Notice that the time and date of when the barcode was scanned is well known and old in the art at the time of invention" and again respectfully *requests evidence to support this Official Notice* in accordance with 37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697.

Applicant's previous and most recent traversal of this objection (i.e. Applicant's Amendment G dated Feb. 18, 2009) is included above in [4.9], *which remains pertinent to the Examiner's current Official Notice* (dated May 01, 2009) objection.

4.11) Examiner's rejection of Claim 15 by citing Petrovich **Para 0067, 0114 and 0060** is moot because Claim 15 is a Dependent Claim.

4.12) Examiner's rejection of Claim 16(a) by citing Petrovich **Para 0005, 0103-0109** is (i) moot because Claim 16(a) is a Dependent claim and (ii) Petrovich does *not* teach Applicant's invention use of a "consumer's first computer" in a *new and unexpected* way as claimed by Applicant's invention.

4.13) Examiner's rejection of Claim 16(b) by citing Petrovich **Para 0005, 0103-0109** is (i) moot because Claim 16(b) is a Dependent claim and (ii) Petrovich does *not* teach Applicant's invention use of a "consumer's first

computer" in a *new and unexpected* way as claimed by Applicant's invention.

4.14) Examiner's rejection of Claim 17 by citing Petrovich **Para 0067** is (i) moot because Claim 17 is a Dependent claim and (ii) Petrovich does *not* teach Applicant's invention use of a "consumer's first computer" in a *new and unexpected* way as claimed by Applicant's invention.

4.15) Examiner's rejection of Claim 18 by citing Petrovich **Para 0132** is (i) moot because Claim 18 is a Dependent Claim and (ii) Petrovich **Para 0132** does *not* disclose all of the interfaces that Applicant's invention claims. Petrovich **Para 0132** simply discloses:

"If another portable terminal is inserted into a different slot while a communication session is in progress, the **serial cradle** will not allow a presently running communication session with a portable terminal to be interrupted. Instead, the serial cradle firmware remembers to establish a communication session with the newly connected portable terminal and executes synchronization thereof after completion of the currently running session."

Clearly this is *not* what Applicant's invention claimed in Dependent Claim 17.

4.16) Examiner's rejection of Claim 19 by citing Petrovich (**see at least Abstract, Para 0012-0017**) is (i) moot because Claim 19 is a Dependent Claim and (ii) neither Petrovich (**see at least Abstract**), nor Petrovich (**Para 0012-0017**) teach Applicant's *new and unexpected use* of a "consumer's first computer" (i.e. *not* a shopping establishment's host computer as taught by Petrovich) *in providing a shopping list predictive database system*. Furthermore, *nowhere* is it taught, *nor* is it suggested in Petrovich that the

"consumer's first computer", or even the "shopping establishment's host computer" can be a personal computer, or a personal digital assistant, or an Internet appliance or a cell phone.

4.17) Examiner's rejection of Claim 34 by citing Ruppert (**see at least Abstract, Para 0060 or 0103**) is *unclear* because Ruppert is an issued patent and is not listed in paragraphs but in columns and lines. Applicant phoned the Examiner on May 15, 2009 and left a voicemail message for Examiner to please clarify this apparent discrepancy. Examiner returned Applicant's inquiry on May 18, 2009 and stated that this was a "typo" and should read "Petrovich (**see at least Abstract, Para 0060 or 0103**)". This same "typo" was presented in the previous Office Action (dated Oct. 30, 2008, Page 8). In light of this clarification, Examiner's rejection of Claim 34 by citing Petrovich (**see at least Abstract, Para 0012-0017**) is (i) moot because Claim 34 is a Dependent Claim and (ii) neither Petrovich (**see at least Abstract**), nor Petrovich (**Para 0012-0017**) teach Applicant's *use* (i.e. to go shopping with a downloaded shopping list) of a "portable computer device". Furthermore, *nowhere* is it mentioned, *nor* is it suggested, in Petrovich that Petrovich's "portable terminal" can be a personal digital assistant or a cell phone.

4.18) Examiner's rejection of Claim 35 by citing "Rupert" [*sic*] (**see at least Para 0060 or 0103**) is *unclear* because Ruppert is an issued patent and is not listed in paragraphs but in columns and lines. Applicant phoned the Examiner on May 15, 2009 and left a voicemail message for Examiner to please clarify this apparent discrepancy. Examiner returned Applicant's inquiry on May 18, 2008 and stated that this was a "typo" and should read "Petrovich (**see at least Para 0060 or 0103**)". This same error was presented in the previous Office Action (dated Oct. 30, 2008, see Page 8). In light of this clarification, Examiner's rejection of Claim 35 by citing Petrovich (**see at least Para 0060 or 0103**) is (i) moot because Claim 35 is a Dependent Claim

and (ii) *not* all of the options claimed in Applicant's invention are taught or suggested in Petrovich.

- 4.19) Examiner's rejection of Claims 20 and 42 by citing Petrovich (**see at least Para 0014-0016, 0060**) is moot because Claims 20 and 42 are Dependent Claims.
- 4.20) Examiner's rejection (9.) of Claims "36-37, 39, 41, 43-46, and 63-64, the limitations of claims 36-37, 39-41, 43-46 and 63-64, are similar to the limitations of claims 14-15, 17-19, and 34-35; therefore they are rejected under the same rationale" are overcome by Applicant's pertinent rebuttal above in [4] through [4.19].

5. With respect to Applicant's responses above, namely [4] through [4.20], Applicant's cited claims are part of a larger method / system which should be viewed "as a whole" (*Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 [1966]), rather than piecemeal. When viewed "as a whole", Applicant respectfully submits that the invention is *non-obvious* and hence patentable over Petrovich in view Suzuki and Ruppert under 35 USC § 103.

Conclusion

For all of the above reasons, Applicant respectfully submits that the specification and claims are now in proper form, and that the claims all define patentability over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

Very Respectfully,



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Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 21313-1450" on the date below.

Date: 2009, June 17 Lester Sussman Lester Sussman, Applicant